

REMARKS

We acknowledge the Examiner's indication that claim 4 would be allowable if amended to be in independent form to include all of the features recited in any base and intervening claims. We further acknowledge the Examiner's indication that claim 5 would be allowable if amended to address the Examiner's § 112 paragraph rejections. Applicant submits however that they are entitled to greater protection than what is offered by these allowable claims.

We have addressed the Examiner's objections to the drawings and the § 112 paragraph rejections. In particular, we have amended dependent claim 9 to remove reference to the strap with overhang and eyelet. We have also amended dependent claim 5 so as not to recite the feature recited in dependent claim 4 from which it depends.

Prior Art Rejections

The Examiner rejected claims 1, 2, 6, 7 and 9-11 as being obvious and therefore unpatentable over Papst (U.S. 3,053,534) in view of Chontos (U.S. 2,960,345) and Taylor (U.S. 4,716,664) and further in view of GB 1326711 (hereafter "the GB reference"). The Examiner also rejected dependent claim 12 as unpatentable over Pabst, Chontos, Taylor and the GB reference and further in view of Curry (U.S. 5,000,712). Furthermore, the Examiner rejected dependent claims 8 and 13 as unpatentable over Pabst, Chontos, Taylor and the GB reference and further in view of Official Notice. We respectfully traverse.

Applicant's invention of the broadest claim (claim 1 is a children's rocking toy in the form of a stylized horse. The rocking toy has a one-piece basic body made of flexible synthetic foam material with a base formed of a simply curved rocking surface. The body widens in cross section in a continuous and uniform contour from its upper narrow side toward the curved rocking surface at the base. The rocking surface has a non-slip backing of leather or imitation leather.

None of the prior art references cited by the Examiner, whether taken alone, or in any proper combination, teaches or suggests Applicant's invention, as claimed.

The Examiner proposes to combine Papst '534, describing a rocking horse, with Taylor '664, describing a bowling shoe. We respectfully traverse.

In particular, Papst '534 describes a rocking horse formed of a hollow shell of plastic or plastic composition. As noted by the Examiner, the material is characterized (at col. 1, lines 21-22) as being "sufficiently yieldable or flexible," without further definition, but as may be seen from the drawings, the material has structural strength and rigidity sufficient to bear the weight of a rider, even in the form of a light-weight, hollow shell with openings of considerable height and breadth in the opposite side walls. Furthermore, the rocking horse of Papst '534 is completely open at the bottom and rests only upon narrow runners. As a result, there is no "base surface" of any kind similar to that described by Applicant, nor any teaching or suggestion for a non-slip backing thereupon.

The Examiner proposes to combine the teachings of Papst '534 with the teaching in Taylor '664 for a bowling shoe having a roughened leather sole. References may be properly combined only if there is some suggestion in the prior art for making the combination.¹ There is no suggestion in Papst '534 or Taylor '664 for the combination proposed by the Examiner of a rocking horse and a bowling shoe. Papst '534, in fact, has no base surface as described and claimed by Applicant, and therefore no suggestion for a covering thereupon, and, as a result, the teaching of Taylor '664 of a bowling shoe is entirely non-analogous to the rocking horse of Papst '534.

The Examiner also proposes to combine Papst '534 and Taylor '664 with the GB reference, which describes a rocking toy in the form of a synthetic foam block. We respectfully traverse.

Again, references may be properly combined only where suggestion for the combination is found in the references, and the proposed modification cannot render the prior art unsatisfactory for its intended purpose. (see MPEP §2143.01) Here, a stated key object of the invention in Papst '534, described at col. 1, lines 24-31, is as follows:

Yet a further object of the present invention resides in the provision of means contributing to a modernized and light-weight rocking horse structure, which may

¹ *Akzo N.V. v. United States ITC*, 808 F.2d 1471, 1 USPQ2d 1241 (Fed. Cir. 1986).

be fabricated by mass production methods and which is substantially a hollow coniform [sic: cuneiform] or tapering shell of plastic or plastic composition, which shell includes a seating facility, a stand or support therefor with openings or cutout portions... *[emphasis provided]*

In contrast, according to the invention of the GB reference, at p. 1, lines 13-15:

According to the invention, there is formed a rocking toy [with] a body formed entirely of resilient foam material...*[emphasis provided]*

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification.² Clearly, the body construction and materials of Papst '534 and the body construction and materials of the GB reference are mutually exclusive, and there is entirely no teaching or suggestion of the desirability for modifying the references at all, and certainly no suggestion for combining the references in a manner to achieve Applicant's invention.

The Examiner also proposes to combine Papst '534 and Taylor '664 with Curry, Sr. '712, which, at col. 7, line 44, describes a rocking toy have a mane formed of fibrous strands of material. However, Curry, Sr. '712 fails to provide teaching or suggestion of other features of Applicant's invention found lacking above with respect to Papst '534 and Taylor '664.

Finally, the Examiner proposes to combine Papst '534 and Taylor '664 with "Official Notice" of a seat region formed of leather. As above, the "Official Notice" provides no teaching or suggestion of other features of Applicant's invention found lacking with respect to Papst '534 and Taylor '664. Furthermore, "Official Notice" merely signals that no prior art reference teaching the mentioned feature of Applicant's invention was found, which is more an indication of novelty than of obviousness.

On the basis of the above, we submit that all of the claims are distinguishable over the prior art, and thus in condition to be allowed.

² *In re Lulu*, 747 F.2d 703, 233 USPQ 1257 (Fed. Cir. 1984).

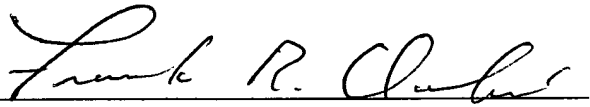
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Page : 8 of 8

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Enclosed is a \$510.00 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050, referencing Attorney Docket Number 13287-002US2.

Respectfully submitted,

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